

## REMARKS

In the Office action made final dated May 29, 2003, pending claims 7 and 15-24 were rejected. Then, applicant filed a response after final rejection pursuant to 37 CFR § 1.116 whereby applicant cancelled claims 15-24 leaving only claim 7. The rejection of claim 7 was confirmed in an Advisory Action dated September 17, 2003. Applicant now cancels claim 7 and submits new claims 25-45.

Applicant has thoroughly reviewed each reference raised by the Examiner during the lengthy prosecution of the present application. Based on the review, applicant believes that each of the new claims is allowable. More particularly, independent claims 25, 32, 39 and 46 each recite at least one element not disclosed or taught by the references raised to date.

### **Claim 25**

Claim 25 recites "wherein a diameter of said perimeter wall of said earpiece cover is less than a diameter of said annular wall of said mouthpiece cover such that said perimeter wall of said earpiece cover is nestable within said annular wall of said mouthpiece cover thereby forming a single compact unit." None of the cited references alone or in combination disclose an earpiece cover and mouthpiece cover being nestable in the manner recited.

The Examiner relies on the combination of the Provence and Guim references for rejecting previous claims reciting a similar element. However, applicant respectfully disagrees with the Examiner's position. First, the combination offered by the Examiner is not proper. That is, one skilled in the art would not look to combine the two references to reach the conclusion reached by the Examiner. There must be a suggestion or motivation to combine references to render a claim obvious. *In re Kozab*, 208 F.3d 1365, 1370 (Fed. Cir. 2000). Here the Examiner has combined a patent directed to a sterilizing device for a telephone handset (Guim) with a patent directed to a telephone handset cover (Provence).

Although both the Provence and Guim references relate to telephone handsets, their subject matter is not related and would not lead one skilled in the art to the conclusion reached by the Examiner. The Guim reference discloses a two piece device for sterilizing

a telephone handset prior to handset use. The sterilization is accomplished by inserting a telephone mouthpiece and/or earpiece into a first mobile container holding a sponge of sterilization material. After use, the first container is fitted into a second fixed container thereby sealing the sponge therein. The Guim reference only discloses the sterilization of germs. To the contrary, the Provence reference discloses a two piece system for covering an earpiece and mouthpiece of a telephone handset. The Provence reference does not suggest sterilization. The purpose of each reference may be similar, namely to prevent germs from spreading, but the means for accomplishing the purpose are wholly unrelated.

Accordingly, one skilled in the art of telephone handset covers would not look to references directed to sterilization of telephone handsets to solve an issue of storing said covers in a compact arrangement. Sterilization is dedicated to killing germs before they contact a telephone user (Guim: column 1, lines 45-49) while the covers are dedicated to preventing live germs from reaching a telephone user (Provence: column 4, lines 49-52). In fact, the references teach away from one another by disclosing two distinct means for controlling germs and protecting a telephone user.

In summary, the combination of the Guim and Provence references is improper and the Examiner has used improper hindsight to reach his conclusion. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000).

Even if proper, the combination does not render claim 1 of the present application obvious. First, the design of the Provence covers includes a series of cutouts (32) on each cover so they can be interlocked during non-use (Figs. 1 and 2). Moreover, each arcuate tab (30) includes an intricate design to facilitate the interlocking ability of the covers during non-use (column 4, lines (30-45). In fact, the claims of Provence include limitations directed to the unique design of the covers and their interlocking features. Thus, by causing a diameter of one of the covers to be made smaller than the other, the entire intricate and claimed design of the Provence covers is circumvented and rendered meaningless.

Further, it is noted that the Provence covers comprise a rigid design which snap into place on the telephone handset (column 3, lines 27-29). By decreasing or increasing the diameter of one of the Provence covers would result in a cover which does not properly fit

over (snap-on) the handset. In other words, for the snap-on design to function, the rigid covers must be precisely and equally sized in accordance with the telephone handset. The resilient nature of the present covers negates any similar concern.

**Claim 32**

Claim 32 recites "wherein said earpiece, mouthpiece or both include a writable surface providing a means for a user to record information." None of the cited references alone or in combination disclose a writable surface on either an earpiece or mouthpiece cover of a telephone handset cover.

The Examiner relies on the Lo reference for rejecting previous claims reciting a similar element. More particularly, the Lo reference discloses that "the telephone covers of the invention may be made of materials on which advertisements have been printed so that when the cover is attached to the phone, phone numbers and the like can be read by the user." (Emphasis added)(Lo: column 3, lines 28-32). As denoted by the underlined portion, the aforementioned passage is directed to placing advertisements on the covers prior to their distribution to users. For example, a taxicab company may be inclined to place its phone number on the covers to encourage users of the covers to access the taxicab company's services when needed. Indeed, the advertisement use is a logical and well-reasoned concept. However, it does not render obvious the "writable surface" element recited in claim 32.

The writable surface is intended for use once the covers are distributed to the users. In other words, the writable surface allows a user to write down or record a phone number or similar information while the information is still fresh in the user's mind. For example, if the user is given an address by an individual on the other end of the telephone, the user may simply and conveniently record the number on the writable surface. Moreover, the surface may be erasable to provide repeated use.

Placing permanent advertisements on a cover does not suggest or teach placing a writable surface on a cover for a user to record information as it is obtained. Again, applicant respectfully disagrees with the Examiner's use of the Lo reference to support his obviousness position.

### **Claim 39**

Claim 39 recites "an earpiece cover fabricated of a resilient material" and "a mouthpiece cover fabricated of a resilient material." None of the cited references alone or in combination disclose a resilient earpiece and/or mouthpiece cover.

The resilient earpiece cover and mouthpiece cover allow the covers to fit snugly over the earpiece and mouthpiece of most telephone handsets. Different telephone handsets may have slightly different sizes which are accommodated by the use of the resilient material. Moreover, manufacturing tolerances may cause commonly manufactured handsets to have different sizes and the covers themselves may be manufactured with varying sizes. The use of the resilient materials minimizes or eliminates fitting problems associated with the aforementioned size differences.

In comparison, the Zimmermann reference teaches a cover made of heavy paper (column 2, lines 17-21). Wachs discloses that the cap material is rather inelastic (column 1, lines 23-24). To fit properly on a handset the Wachs caps include an elastic rubber insert (column 1, lines 24-26). The Provence reference discloses covers having a rigid design which snap into place on the telephone handset (column 3, lines 27-29). The Lo reference teaches a cover using soft paper or plastic (column 1, lines 37-39). Thus, none of the references discloses the use of resilient material for the covers.

### **Claim 46**

Claim 46 includes each of the elements discussed above with respect to claims 25, 32 and 39 and therefore should be allowable as well.

### **CONCLUSION**

As claims 25, 32, 39 and 46 each recite at least one element not disclosed or suggested by the references cited by the Examiner, applicant believes each of the independent claims, and their dependents, is allowable. In particular, independent claim 25 recites an earpiece cover and mouthpiece cover having different diameters so that the two covers may nest inside one another to form a single compact unit. Independent claim 32 recites a writable surface for allowing a user to write notes or other information of said surface. Independent claim 39 recites that the earpiece cover and mouthpiece cover are fabricated of a resilient material. Independent claim 46 recites each of the elements.

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees which may be required by this paper to Deposit Account No. 502466 including any fee for extension of time, or the fee for additional claims which may be required. Please show our docket number with any Deposit Account transaction. **A copy of this letter is enclosed.**

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Respectfully submitted,

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